



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/147,237 04/20/99 YAGI

E TOS-123-USA

EXAMINER

HM12/0801

TOWNSEND & BANTA
1225 EYE STREET NW
SUITE 500
WASHINGTON DC 20005

PRATS, F

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

08/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/147,237

Applicant(s)

YAGI ET AL.

Examiner

Francisco C Prats

Art Unit

1651

--The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

THE REPLY FILED 23 July 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): § 112, second paragraph.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-4 and 15-17.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other:

Francisco C Prats
Primary Examiner
Art Unit: 1651

ATTACHMENT TO ADVISORY ACTION

1. The after-final amendment filed July 23, 2001, has been received and will be entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

2. The rejection under § 112, second paragraph, will be withdrawn in view of the amendment of July 23, 2001. However, it is respectfully submitted that the pending rejections under §§ 102 and 103 remain proper. All of applicant's argument regarding the §§ 102 and 103 rejections has been fully considered and reconsidered but is not persuasive of error. As discussed in the previous office action, it is respectfully submitted that the N'Guyen reference is properly held to anticipate and/or render obvious the pending claims. It is again noted that the reference refers to a "complexing agent-thiol couple". It is also noted that coupling reactions are known in the art. It is further noted that if the glutathione becomes covalently coupled to the EDTA complexing agent in N'Guyen's compositions, it would then appear that N'Guyen's compositions are not encompassed by the "consisting essentially of" language currently appearing in applicant's claims.

However, as pointed out in the previous office action,

there is nothing in the reference indicating that the glutathione and the EDTA complexing agent were subjected to conditions such that the two agents would be "coupled" through covalent bonding, or through electrostatic interaction, or any other type of binding, as alleged by applicant.

Further still, as also discussed in previous office actions, the MPEP clearly places upon applicant the burden of establishing that the additional ingredients in prior art compositions or processes materially affect the basic and novel properties of inventions recited in "consisting essentially of" terminology. As discussed in the previous office action, MPEP 2111.03 explicitly provides that "[w]hen an applicant contends that additional steps or materials in the prior art are excluded by the recitation of 'consisting essentially of,' applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention." No factual evidence has been provided to demonstrate that the glutathione and EDTA in N'Guyen's become coupled, covalently or otherwise. Thus, it is respectfully submitted that the rejections of record are properly maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francisco

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C Prats whose telephone number is 703-308-3665. The examiner can normally be reached on Monday through Friday, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Francisco C Prats
Primary Examiner
Art Unit 1651

FCP
August 1, 2001